

Customer No.: 31561
Application No.: 10/710,040
Docket No.: 12340-US-PA

REMARKS

Current Status

This is a full and timely response to the outstanding final Office Action mailed Jul. 07, 2006. Applicants submit that the specification, i.e., paragraph [0022], has been amended, in which description presented in the drawings, specifically FIGS. 3A and 3B, are introduced therein. Applicants also submit that claim 1 has been amended as to remove a previously added limitation, i.e., "wherein each of the fins has a long strip shape of uniform width", which has been written as a new claim 14, and include all subject matter presented in originally filed claim 2, whereby claim 2, accordingly, has been canceled, and the dependency of other claims on originally filed claim 2 has also been rearranged as is. Claim 3, has been currently rewritten into independent form with all subject matter presented in originally filed claim 1.

Applicants submit that all changes to the claims and the new claim 14 are supported by claims 1-13, as originally or previously presented, which have been fully considered by the Examiner. As such, there is no new matter entered hereby. Entering of the amended specification, claims, and reconsideration and allowance of the application and presently pending claims 1-13, and new claim 14, are respectfully requested.

Claim Objection

The specification is objected to as failing to provide proper antecedent basis for claimed subject matter.

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In response thereto, Applicants have amended the specification. Specifically, supported by the drawings, i.e., FIGS. 3A and 3B, corresponding antecedent basis has been added into paragraph [0022] in compliance with the requirements as set forth in 37 CFR 1.75(d)(1) and MPEP §608.01(o). Furthermore, Applicants submit that the specified limitation has been separated from claim 1, and rewritten into a new claim 14. As such, Applicants submit that the specification, in its current form, provides sufficient antecedent basis for claim 1, as currently amended, and claim 14, as newly added.

Claims 5 and 9 are objected to because of feature of "each of the fins is shaped into a long strip" has been previously recited in claim 1, on which claims 5 and 9 directly or indirectly depend.

In response thereto, Applicants have amended claim 1, in which the specified feature has been removed therefrom. As such, Applicants submit that claims 5 and 9 are now in allowable forms.

Claim Rejections – 35 U.S.C. § 103

The Office Action rejects claim 10 under 35 U.S.C. 103(a) as being unpatentable over Miyahara 6,439,299 in view of Lin 6,751,097.

In response to the rejections to claims 1-13 under 35 U.S.C. 103(a) as being unpatentable over Miyahara in view of Lin, Applicants submit that claim 2, as originally filed, is novel and

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unobvious over Miyahara and Lin, taken alone or in combination, and accordingly submit claim 1 has been amended to include all subject matter presented in claim 2 as originally filed. As such, Applicants submit that 1-13 are novel and unobvious over Miyahara and Lin, or any of the other cited references, taken alone or in combination, and thus should be allowed.

With respect to claim 2, as originally filed, recites:

The fan module of claim 1, wherein an inner wall of the casing at the air outlet separates from the nearest fin through the first protruding sections to form another narrow slot.

Applicants noted that in rejecting claim 2, the Examiner contended “[A]s seen in figure 9, an inner wall of the casing at the air outlet separates from the nearest fin near 9 through the first protruding sections 9 to form another narrow slot” (Page 4, second paragraph of the current Office Action). However, such a feature cannot be found in figure 9 of Miyahara, since “FIG. 9 is a plan view showing a further modification of a heat sink ...” (Col. 1, lines 66-67; Emphasis added) and there is no “first protruding sections” alleged by the Examiner could be seen. Applicants respectfully suggest the Examiner refer to FIG. 6, from which FIG. 9 is modified and on which the Examiner mostly relied, in evaluating this feature. As seen in FIG. 6, there are two inner walls of the alleged casing 1/16, a bottom inner wall and a top inner wall. The bottom inner wall is in close contact with its nearest fin, herein plate-like member 10, thus there is no another narrow slot defined thereby. The top inner wall 16 of the air outlet separates from the nearest fin, herein plate-like member 14, to form another narrow slot (between 16 and 14). However, the limitation of “through the first protruding sections” is not satisfied thereby. Since

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neither the bottom inner wall, nor the top inner wall of the air outlet qualifies as the “inner wall” that is required by originally filed claim 2, claim 2 as originally filed, is submitted to be novel and unobvious over Miyahara, Lin, or any of the other cited references, taken alone or in combination, and claim 1, as current amended to include all of the allowable subject matter presented in originally filed claim 2, should be allowable.

With respect to claim 3, as originally filed, recites: “wherein the first protruding sections are formed by bending a cut portion of the fins relative to an uncut portion of the fins”. Likewise, claim 8, as originally filed, recites: “wherein the second protruding sections are formed by bending a cut portion of the fins relative to an uncut portion of the fins”.

In rejecting originally filed claims 3 and 8, the Examiner contributed claims 3 and 8 as product-by-process claims. The Examiner further stated: “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself” and “[I]f the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)” (Page 5 of the current Office Action).

Applicants respectfully disagree with the Examiner on this point and traverse the conclusion drawn by the Examiner as the Examiner failed to provide evidence showing that “the

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product in the product-by-process claim is the same as or obvious from a product of the prior art" that is a prerequisite of the conclusion.

Applicants respectfully submit that the case law of *In re Thorpe*, is not applicable of the current claimed invention. *In re Thorpe*, "the product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate", and "[T]he fact that the metal carboxylate is not directly added, but is instead produced in-situ does not change the end product" (MPEP §2113). On the contrary, structures disclosed in the cited prior art references, e.g., Miyahara, could not be obtained by the process given as set forth in either claim 3, or claim 8. Applicants submit that the manufacturing process steps of either "bending a cut portion of the fins relative to an uncut portion of the fins" to form the "first protruding sections" or "the second protruding sections" impart distinctive structural characteristics to the final fan module, as set forth in claims 3 and/or 8. For example, the structures obtained from process of either claim 3 or claim 8, could be returned back to a flat form by undoing or reversing such a bending process.

It has been held that "[T]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. *In re Garnero*, 412 F. 2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

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Therefore, claims 3 and 8 are submitted to be novel and unobvious over Miyahara, Lin, or any of the other cited references, taken alone or in combination, and thus should be allowed.

Applicants have rewritten claim 3 into independent form including all subject matter of claim 1, as originally filed, on which it depended from. As such, Applicants submit that claim 3, as currently amended is novel, unobvious over Miyahara, Lin, or any of the other cited references, taken alone or in combination, and thus should be allowed.

If independent claim 1 is allowable over the prior art of record, then its dependent claims 4-13 are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

New Claim

Claim 14 is drawn from claim 1, as previously presented and depend on allowable claim 1, as current amended, and is submitted to be allowable hereby.

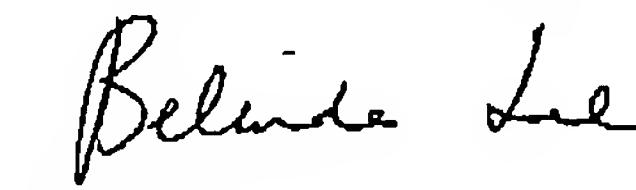
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CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1, 2-14 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Respectfully submitted,

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